



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
JORDAN, K

WENDEROTH, LIND & PONACK
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WASHINGTON, DC 20005

ART UNIT PAPER NUMBER
1205

DATE MAILED: 04/09/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined. ☒ Responsive to communication filed on 12/19/91 & 1/23/92 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|-------------------------------------------------------------------------------------|---------------------------------------------------------------------------------|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 11-16 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 1-10 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 11-16 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☒ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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Claims 11-16 are remaining in this application.

The amendments received on December 19, 1991, and January 23, 1992, have been entered.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 11-16 are rejected under 35 U.S.C. § 103 as being unpatentable over Wang et al. (R) and Sethi et al. (S). The claims appear to be drawn to compositions and methods for treating malaria with benflumetol and arteether analogues. Wang et al. discloses that benflumetol is a known antimalarial drug.

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Sethi et al. discloses that arteether is a known antimalarial drug. The claimed subject matter differs from the disclosure of the primary references in claiming the combination of both drugs at the same time for the same purpose and specific amounts to be combined together. It is prima facie obvious to combine two compositions each of which is taught by prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. Thus, claims that require no more than mixing together of two known antimalarial drugs set forth prima facie obvious subject matter. (In re Kerkhoven, 205 U.S.P.Q. 1069). The claimed subject matter fails to patentably distinguish over the state of the art as represented by the cited references.

The applicants remarks have been considered but are unpersuasive. Although the claims are directed to synergistic compositions containing benflumetol and arteether analogues, the specification does not provide clear and convincing unexpected results. The claims are not limited to the specific compounds and amounts tested in the specification. Furthermore, it has not been established that the range recited in the claims is critical for synergism. Finally, the remarks regarding the effectiveness of each compound at various stages of antimalarial treatment are not persuasive since such criticality is not reflected in the

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claims nor is it substantiated by evidence in the specification.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 11-16 are rejected under 35 U.S.C. § 102(a) as being anticipated by WHO report (AR).

Note that it is not clear from the WHO report that the meeting was closed and that the material disclosed or discussed therein was given in confidence.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(f) he did not himself invent the subject matter sought to be patented.

Claims 11-16 are rejected under 35 U.S.C. § 102(f) because the applicant did not invent the claimed subject matter.

The WHO report (AR) discloses that the compounds of the claims are being administered together in China as an antimalarial treatment. It is unknown to the Examiner as to whether it is the applicants or others that are practicing this method.

No claims are allowed.

Any inquiry concerning this communication or earlier

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communications from the examiner should be directed to Kimberly Jordan whose telephone number is (703) 308-4611.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

JORDAN;chs
April 07, 1992

KJ


Frederick E. Waddell
Supervisory Patent Examiner
Group 120